

REMARKS

Claims 1-10, 12-21, 31-69 and 71-73 were pending in the December 3, 2009 non-final Office Action. Support for claim amendments can be found in the specification at least on pages 22-25. Reconsideration and further examination are respectfully requested.

§ 101 Rejections

Claim 73 was rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In order to expedite prosecution and without conceding to the rejection, claim 73 has been amended. Therefore, the Applicant respectfully requests the Examiner to withdraw the § 101 rejection.

§ 102 Rejections

Claims 1-10, 12-18, 66-68 and 71-73 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by PCT Publication No. WO 00/38074 (Kay).

Claim 10 recites “providing an electronic document including a link to the network based locator without providing the advertisement image; receiving an indication of a user **accessing the electronic document** . . . transmitting one of the advertisement image or the modified advertisement image for inclusion when the electronic document is **presented to the user upon receiving the indication of the user accessing the electronic document, wherein the advertisement image or the modified advertisement image is presented in the electronic document being displayed for the user.**” Kay does not teach or suggest these features.

The cited portions of Kay indicate that when a view-op becomes available, its properties are compared to the properties set out in the various bids and the highest matching bid is selected. *See* page 16. Kay further provides that a determination is made as to whether or not this view-op is needed to meet the schedule set out in the winning bid, if not then the view op is assigned to the next lower matching bid. *See id.* If it is needed to meet the schedule, a check is made to determine if the initialization period is over. *See id.* The cited portions of Kay are silent as to *any* teaching or suggestion of “providing an electronic document including a link to the network based locator **without providing the advertisement image,**” as recited in claim 10. The relied upon portions are merely comparing properties of a view-op when it becomes

available and determining if a view-op (an advertisement) meets a schedule. The relied upon portions of Kay also do receive *any* "indication of a user **accessing the electronic document . . .** and transmitting one of the advertisement image or the modified advertisement image for inclusion **when the electronic document is presented to the user upon receiving the indication of the user accessing the electronic document**, wherein the advertisement image or the modified advertisement image is presented in the electronic document being displayed for the user" as recited in claim 10.

Therefore, the Applicant respectfully asserts that Kay does not teach or suggest "providing an electronic document including a link to the network based locator without providing the advertisement image; receiving an indication of a user accessing the electronic document . . . transmitting one of the advertisement image or the modified advertisement image for inclusion when the electronic document is presented to the user upon receiving the indication of the user accessing the electronic document, wherein the advertisement image or the modified advertisement image is presented in the electronic document being displayed for the user," as recited in claim 10.

Applicant respectfully requests the Examiner withdraw the 102(b) rejection of claim 10. Claims 12-18 depend from claim 10 and are allowable for at least the same reasons set forth above with respect to claim 10.

Claim 1 recites "receiving an indication of a user accessing the electronic document . . . transmitting one of the advertisement image or the modified advertisement image for inclusion when the electronic document is presented to the user upon receiving the indication of the user accessing the electronic document, wherein the advertisement image or the modified advertisement image is presented in the electronic document being displayed for the user." Claim 1 is allowable for at least the same reasons set forth above with respect to claim 10. Claims 2-9 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

Claim 71 recites "providing an electronic document including a link to the network based locator without providing the advertisement image; receiving an indication of a user accessing the electronic document . . . transmitting one of the advertisement image or the modified advertisement image for inclusion when the electronic document is presented to the user upon

receiving the indication of the user accessing the electronic document, wherein the advertisement image or the modified advertisement image is presented in the electronic document being displayed for the user.” Claim 71 is allowable for at least the same reasons set forth above with respect to claim 10.

Claim 72 recites “providing an electronic document including a link to the network based locator without providing the advertisement image; receiving an indication of a user accessing the electronic document . . . transmitting one of the advertisement image or the modified advertisement image for inclusion when the electronic document is presented to the user upon receiving the indication of the user accessing the electronic document, wherein the advertisement image or the modified advertisement image is presented in the electronic document being displayed for the user.” Claim 72 is allowable for at least the same reasons set forth above with respect to claim 10.

Claim 73 recites “providing an electronic document including a link to the network-based locator without providing the advertisements as part of the electronic document transmission; receiving an indication of a user accessing the electronic document; transmitting the highest ranking advertisement for inclusion in the electronic document upon receiving the indication of the user accessing the electronic document, wherein the highest ranking advertisement is included in the electronic document at the time of presentation of the electronic document for the user.” Claim 73 is allowable for at least the same reasons set forth above with respect to claim 10.

§ 103 Rejections

Claim 69 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kay, in view of Official Notice. The Applicant refers the Examiner to MPEP § 2144.03. In relevant part, MPEP § 2144.03 states, “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” Applicant submits that the Examiner has made a generalized statement without any documentary evidence to support it. Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicant submits that the Examiner must provide “specific factual

findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." In re Soli, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA 1963).

Claim 69 depends, indirectly, from claim 1 and is allowable for at least the same reasons set forth above with respect to claim 1. Claim 70 has been cancelled rendering this rejection moot.

Conclusion

For the foregoing reasons, the Applicant submits that all the claims are in condition for allowance. By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicant's decision to amend or cancel any claim should not be understood as implying that the Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

4.5.10



Leila R. Abdi
Reg. No. 52,399

Customer No. 26192
Fish & Richardson P.C.
Telephone: (404) 892-5005
Facsimile: (877) 769-7945